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EXAMINER

REAGAN, JAMES A

ART UNIT PAPER NUMBER

3621

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,433

Applicant(s)

WONG ET AL.

Examiner

James A. Reagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-12 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-12, and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in response to the amendment and RCE filed on 23 September 2005.
2. Claims 1, 8, 11, and 18 have been amended.
3. Claims 1, 2, 5-12, and 15-19 have been examined.

RESPONSE TO ARGUMENTS

4. Applicant's received arguments have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

With regard to the limitations of claims 1 and 11, Applicant argues that the Applicant's background in the specification does not fully disclose a run-time files. However, the background explicitly discloses installation and execution of software, inherently disclosing the necessity and utilization of run-time files.

Applicant's addition of the Hardware identifier clauses in the claimed limitations have been addressed in the rejections below.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 5-12, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneck et al, (US 5,933,498 A) in view of Alexander et al. (US 6,134,593 A), in view of Slivka et al. (US 6,049,671 A), and further in view of Applicant's own admissions.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claims 1, and 11:

Schneck, as shown, discloses:

- *generating an installer identifier at the local machine based on the software product in response to a request to install the software product on the local machine* (see at least Fig 1-3; associated text; Fig 3: Items 127, 128, 130: "Version Number 127; Authentication 128; License Number of these Rules 130);

- *the generated installer identifier represent a characteristic of the software product medium on which the software product is stored (see at least Fig 3; associated text; Col 10, L59 - Col 11, L43).*
- *comparing the generated installer identifier to a stored installer identifier on the software product (see at least above citations; Fig 10(a-b); Col 17-20: "The Accessing Operation");*
- *storing a license file and a hardware identifier identifying the local machine on the local machine in response to a match between the generated installer identifier and the stored installer identifier (see at least Fig 11; associated text; Col 22, L51 - C24, L38; Schneck's "Rules" are equivalent to applicant's "license"); and*
- *enabling a complete installation of the software product on the local machine, including installing at least one run-time file needed to execute the software product, in response to the match between the generated installer identifier and the stored installer identifier; (see at least all above citations; Col 30, L6-47);*
- *whereby the stored license file is associated only with the software product installed on the local machine and the hardware identifier is associated only with the local machine and the stored license file can be subsequently accessed to enable the execution of the completely installed software product including the installed at least one run-time file on the local machine but cannot be used with a separate software product or to execute the software product on a machine other than the local machine (see at least same citation as above).*

Schneck does not specifically disclose that the above teachings may be applied to software installation on a local machine, with software identifiers as particularly claimed by the instant invention. Alexander, however, in an analogous art directed explicitly to the installation of software product onto client machines, does disclose these features. See at least the brief summary and other detailed and associated text. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the System for Controlling Access and

Distribution of Digital Property as disclosed by Schneck with Alexander's software installation techniques because software is a subset of digital property.

With regard to the Applicants inclusion of a hardware identifier, Schneck discloses utilizing the hardware serial number for generating a key (see at least column 14, lines 32-50). Since the serial number of the system is unique to the system itself, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Schneck to use the system's serial number as a hardware identifier for the purposes of controlling the installation of software onto the selected machine.

The combination of Schneck/Alexander does not specifically disclose the hashing algorithm and associated steps as claimed above and disclosed in the specification. Slivka, however, in at least column 18, lines 6-15 discloses installation of a software product only after ensuring hash values are identical. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the System for Controlling Access and Distribution of Digital Property as disclosed by Schneck with Alexander's software installation techniques and modify them to include Slivka's hashing technique because this ensures that the "...self-extracting executable distribution file is deemed secure and free from accidental or intentional corruption."

The combination of Schneck/Alexander/Slivka does not specifically disclose machine, including installing at least one run-time file associated with the software product. Applicant, however, in the background of the specification, page 2, does. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the System for Controlling Access and Distribution of Digital Property as disclosed by Schneck/Alexander/Slivka with Applicant's well-known use of a run-time executable file because it is a well-known technique for installing applications locally on an end-user's machine.

Claims 2 and 12:

The combination of Schneck/Alexander/Slivka/AOA discloses all the limitations of claims 1, and 11. Schneck further discloses *a computer readable medium having stored thereon computer-executable instructions for performing the method of claims 1 and 11* (see at least Col 7, L27-34).

Claims 5 and 15:

The combination of Schneck/Alexander/Slivka/AOA discloses all the limitations of claims 1, and 11. Schneck further discloses *the generated installer identifier represents a characteristic of a file list corresponding to the software product media* (see at least Fig 3; associated text; Col 10, L59 - Col 11, L43).

Claims 6 and 16:

The combination of Schneck/Alexander/Slivka/AOA discloses all the limitations of claims 1, and 11. Schneck further discloses *the generated installer identifier is a hash value representing the characteristic of the file list corresponding to the software product media* (see at least Fig 3, "Authentication (hash) 128").

Claims 7 and 17:

The combination of Schneck/Alexander/Slivka/AOA discloses all the limitations of claims 1, and 11. Schneck further discloses *receiving a software product key* (see at least Fig 5; associated text; Col 12, L1-65).

Claims 8 and 18:

The combination of Schneck/Alexander/Slivka/AOA discloses all the limitations of claims 1, and 11. Schneck further discloses *installing on the local machine the at least one run-time file needed to execute the software product, occurs in response to a determination that the received*

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software product key is a correct software product key (see at least Col 18, L52-61; Col 34, L14-28).

As per claim 9:

The combination of Schneck/Alexander/Slivka/AOA discloses all the limitations of claims 1, and 11. Schneck further discloses *executing a set-up program* (see at least Col 30, L5-28).

Claims 10 and 19:

The combination of Schneck/Alexander/Slivka/AOA discloses all the limitations of claims 1, and 11. Schneck further discloses *the license file is stored in a hardware signature file* (see at least Col 7, L63 - Col 8, L5; Col 12, L1-16).

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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or faxed to:

571-273-8300 [Official communications, After Final communications labeled "Box AF"]

571-273-8300 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

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JAR

18 October 2005

